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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,298	01/31/2001	Brian Mark Shuster	409475-11	6400

7590 01/28/2004

O'MELVENY & MYERS LLP  
400 South Hope Street  
Los Angeles, CA 90071-2899

EXAMINER

THOMPSON JR, FOREST

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/773,298

Applicant(s)

SHUSTER ET AL.

Examiner

Forest Thompson Jr.

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**Period for Reply**  
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-19 have been examined.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Microsoft Press Computer Dictionary, Third Edition," Microsoft Press, 1997 (hereafter referred to as **Microsoft Press**), and further in view of Lichty, Tom; Watson, Jennifer; "The Official America Online Tour Guide," The Coriolis Group, Inc.; 1997 (hereafter referred to as **AOL97**).

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Claims 1-19: The disclosures of Microsoft Press combined with AOL98 encompass all of the aspects of applicants' claimed invention. Microsoft Press discloses (at pg. 506) "Many large corporations, such as corporations, will have a single Web site. However, an HTTP server can also serve several small Web sites, such as those owned by individuals. Users need a Web browser and an Internet connection to access a Web site." This disclosure encompasses applicants' inventive aspect of acquiring registration authority over all Internet sub-domain names from an owner of a domain name. The corporation presented in this disclosure encompasses America Online (AOL), as disclosed in AOL98. For example, AOL98 explicitly discloses:

- (at pg. 111-131) the functionality, sale and use of domain names and the Internet. Also disclosed is the functionality of individual users registering as AOL users and developing individual user home pages. A buyer registering and becoming an AOL user encompasses the sale of sub-domain names for use by buyers. Each user is provided with the capability to create his own individual home page and sub-domain name.
- (at pg. 120) "Your Personal Home Page. As a member of America Online, you can have your own website, with your own home page. AOL even offers a number of tools to help you construct and maintain it."
- (at pg. 120) "Your Web page will reside within the [http:// members . aol . com /](http://members.aol.com/) domain, with your screen name appearing after the concluding slash."
- (at pg. 438-443) registering with the AOL service.

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Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the disclosures of Micropress Press and AOL98 to explicitly disclose the claimed aspects of applicants' invention, for the motivation of providing a domain name service by a domain name manager to users of the Internet that want Internet presence.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

- Farris et al. (U.S. Patent No. 5,881,131) that discloses an administration system for a public switched telephone network (PSTN) that includes a service order processing system receiving a service request from a customer requesting service for a customer location, and determining whether the service request is provisionable responsive to the service request and predetermined criteria.
- Mann et al. (U.S. Patent No. 6,298,341) that discloses new and improved systems and methods for generating and facilitating registration and transfer of available domain names.
- Schneider (U.S. Patent No. 6,338,082) that discloses, when a network resource request having a domain name is received, it is determined whether the network resource can be located including determining whether the domain name is resolvable. Rather than displaying an error message or processing a search request in response to determining that a network resource can not be located or of an unresolvable domain

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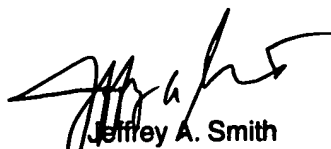
name, the domain name can instead be redirected to a registration service where the unresolvable domain name is automatically used to perform a registration request and determine domain name availability. .

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

FT   
14 January 2004

  
Jeffrey A. Smith  
Primary Examiner